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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,383	03/11/2005	Stephen D. Newman	40302-0033	5729
37526 7590 11/10/2009 RADER, FISHMAN & GRAUER PLLC 10653 SOUTH RIVER FRONT PARKWAY SUITE 150 SOUTH JORDAN, UT 84095				
EXAMINER REYNOLDS, STEVEN ALAN				
ART UNIT		PAPER NUMBER		
3728				
MAIL DATE		DELIVERY MODE		
11/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/527,383

**Applicant(s)**

NEWMAN ET AL.

**Examiner**

Steven Reynolds

**Art Unit**

3728

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 77, 85 and 99 is/are pending in the application.
- 4a) Of the above claim(s) 99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 77 and 85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/2009 has been entered.

### *Election/Restrictions*

2. Upon further consideration of the claims, Claim 99 is directed toward the subject matter shown in Fig. 27A, which corresponds to Non-elected Species 11. **Claim 99 is hereby withdrawn from consideration as being directed to a non-elected species.**

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 77 and 85 are rejected under 35 U.S.C. 102(b) as being anticipated by Artis (US 5,699,900). Regarding claim 77, Artis discloses a reusable holder (10) for contact lens cases comprising: a base (base portion 10 in Fig. 1); one or more

receptacles (opening/cavity 12 is considered a receptacle) formed in said base configured to receive a contact lens case (holder 34 is considered a contact lens case as it at least partially encases a contact lens); and a time keeping device (counter 40); wherein the time keeping device comprises an indicator for each one or more receptacles that can indicate a period of time that has elapsed since the contact lens case currently in the receptacle was placed therein to denote a need to discard said contact lens case and a contact lens associated with said contact lens case; wherein said one or more receptacles configured to receive a contact lens case includes: a contact lens case engagement surface (threaded surface at 12 – See Fig. 1) formed on said one or more receptacles configured to lock said contact lens case in said one or more receptacles; and an actuator (button 42) formed in said base, wherein said actuator is configured to be triggered and reset said time keeping device when a contact lens case is received in said one or more receptacles, further comprising at least one contact lens case (34); wherein the contact lens case comprises a bottom member (38) having a fluid retaining well with a generally concave shape; wherein the contact lens case has a top (20) and a bottom (39); and wherein the bottom of the contact lens case is placed in the receptacle and then rotated 90 degrees to snap the bottom of the case into the receptacle (when the contact lens case is placed on the base 10, the cap can be rotated 90 degrees to engage the threads on the base).

Regarding claim 85, Artis discloses a reusable holder for contact lens cases comprising: a base (base portion 10 – See Fig. 1); one or more receptacles (opening/cavity 12 is considered a receptacle) get formed in said base configured to

receive a contact lens case (holder 34 is considered a contact lens case); and a time keeping device (counter 40); wherein the time keeping device comprises an indicator for each one or more receptacles that can indicate a period of time that has elapsed since the contact lens case currently in the receptacle was placed therein to denote a need to discard said contact lens case and a contact lens associated with said contact lens case; wherein said one or more receptacles configured to receive a contact lens case includes: a contact lens case engagement surface (threaded surface at 12 – See Fig. 1) formed on said one or more receptacles configured to lock said contact lens case in said one or more receptacles; and an actuator (button 42) formed in said base, wherein said actuator is configured to be triggered and reset said time keeping device when a contact lens case is received in said one or more receptacles; wherein said actuator comprises a mechanically actuated timer reset switch disposed in said one or more receptacles; and wherein said mechanical timer reset switch is configured to engage a surface of a contact lens case being inserted into said receptacle and automatically reset the time keeping device when a contact lens case is inserted into the receptacle.

### ***Response to Arguments***

5. Applicant's arguments filed 10/22/2009 have been fully considered but they are not persuasive. Applicant argues that the holder 34 of Artis does not encase the lenses, therefore can not be considered a contact lens case. Contrary to Applicant's argument, the term "case" does not limit the element to have to fully encase the article in which it

holds. The holder 34 can be considered a case as it at least partially encases/holds the article(s) between uses.

Applicant argues that counter 40 of Artis is not a time indicator. Contrary to Applicant's argument, the counter 40 of Artis can be considered a time keeping device as it keeps track of the number of times the device was used; and for example, if the user used the device at the same time each day, the counter could indicate the number of days/hours the device was used.

Applicant argues that Artis fails to teach an actuator that automatically resets each time a contact lens case is received. Contrary to Applicant's argument, the device of Artis is considered to "reset" each time the contact lens case is received as the counter is reset to the next number each time it is received therein. The term "reset" does not limit the time keeping device to reset to zero.

Applicant argues that Artis fails to teach a contact lens case having a fluid retaining well. Contrary to Applicant's argument, the cavity between baskets 36 and 38 of Artis can be considered a fluid retaining well as the cavity retains fluid when element 34 is disposed within the receptacle 10.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Reynolds whose telephone number is (571)272-9959. The examiner can normally be reached on Monday-Friday 9:30am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. R./  
Examiner, Art Unit 3728

/Mickey Yu/  
Supervisory Patent Examiner, Art  
Unit 3728